

11 NANTWORKS, LLC, et al.,  
12 Plaintiffs,  
13 v.  
14 Niantic, Inc.,  
15 Defendant.

11 Case No. 20-cv-06262-LB

12 **ORDER GRANTING MOTION TO  
13 STRIKE IN PART**

14 Re: ECF No. 228

17 **INTRODUCTION AND STATEMENT**

18 NantWorks sued Niantic for infringing NantWorks' three patents in Niantic's augmented-  
19 reality (AR) game apps Pokémon Go and Harry Potter: Wizards Unite. Both games use the camera  
20 and GPS system on a mobile device and an AR platform to superimpose AR objects onto digital  
21 representations of a mobile device's actual surroundings. For example, the game app Pokémon Go  
22 sends users on scavenger hunts to collect virtual objects (such as Pokémon characters), which are  
23 represented on the mobile device as if they are in the player's real-world location.<sup>1</sup> There is now  
24 one patent remaining in the case: US Patent No. 10,403,051 (the '051 patent).<sup>2</sup>

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27 <sup>1</sup> Third Am. Compl. – ECF No. 50. Citations refer to material in the Electronic Case File (ECF);  
pinpoint citations are to the ECF-generated page numbers at the top of documents.

28 <sup>2</sup> Orders – ECF Nos. 35, 149.

1 Following expert disclosures, Niantic moves to strike certain infringement theories in the  
2 opening expert report of Matthew Turk. Niantic contends that these theories were not disclosed in  
3 NantWorks' infringement contentions.<sup>3</sup> The court grants the motion in part.  
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## 5 ANALYSIS

6 After the initial case-management conference, any party claiming patent infringement must  
7 serve its infringement contentions containing “[a] chart identifying specifically where and how  
8 each limitation of each asserted claim is found within each [accused apparatus, product, device,  
9 process, method, act, or other instrumentality].” N.D. Cal. Patent L.R. 3-1(c). Such parties are then  
10 expected “to proceed with diligence in amending those contentions when new information comes  
11 to light in the course of discovery.” *Verinata Health, Inc. v. Ariosa Diagnostics, Inc.*, 236 F. Supp.  
12 3d 1110, 1112 (N.D. Cal. 2017). “[A] party may not use an expert report to introduce new  
13 infringement theories [or] new infringing instrumentalities” that were not disclosed in its  
14 infringement contentions. *Huawei Techs. Co. v. Samsung Elecs. Co.*, 340 F. Supp. 3d 934, 946  
15 (N.D. Cal. 2018) (cleaned up). “In determining whether to strike some or all of an expert report for  
16 failure to comply with the patent local rules, courts in this district have asked” whether doing so  
17 would make the litigation “more fair.” *Id.* (cleaned up).

18 Niantic’s motion focuses on NantWorks’ infringement theories related to Pokémon Go’s  
19 allegedly infringing the ’051 patent. The ’051 patent is directed to incorporating virtual objects  
20 into a digital representation of an actual scene surrounding a device (such as a mobile phone). The  
21 first issue is whether paragraphs 134 through 149 of the Turk Report should be stricken on the  
22 ground that they introduce new infringement theories related to claim 1 of the ’051 patent. Claim 1  
23 requires “determin[ing] whether to alter presence of a relevant AR object based on at least the  
24 device location and the virtual element attribute.”<sup>4</sup> (NantWorks’ infringement contentions, served  
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27 <sup>3</sup> Mot. – ECF No. 228.  
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<sup>4</sup> U.S. Patent No. 10,403,051 (filed Nov. 9, 2018) – ECF No. 114-2.

1 on January 28, 2021, asserted that Pokémon Go infringes claim 1 and claims depending from  
2 claim 1.<sup>5</sup>)

3 Niantic contends that the infringement contentions identified only the “Map View”  
4 functionality in Pokémon Go (“in which the user’s avatar, Pokémon, and other elements are  
5 shown on top of an aerial view of a world map”) and accused only two functionalities of Map  
6 View: (1) Pokémon types appearing more or less frequently on the aerial view “based on real-  
7 world weather at a user’s real-world location,” and (2) Pokémon near the user’s location on the  
8 aerial view appearing “large and in color” and Pokémon further from the user’s location appearing  
9 as “small shadowy icons at the bottom of the screen.”<sup>6</sup> By contrast, the Turk Report (in its  
10 paragraphs 134–49) relies not on Map View but “on the distinct ‘Encounters’ functionality of  
11 Pokémon Go” to argue that the “determin[ing] whether to alter presence” limitation is infringed.  
12 “Unlike the aerial, high-level Map View, Pokémon Go’s ‘Encounters’ functionality allows a user  
13 to view a Pokémon up close through a smartphone’s camera.” The Turk Report relies on  
14 Encounters-specific functionality, such as a Pokémon jumping out of a bush at a set distance from  
15 the user.<sup>7</sup>

16 NantWorks counters that even if its infringement contentions cited Map View as an example,  
17 the contentions disclosed a broader feature that applies to either Map View or Encounters:  
18 “changing the size and visibility of the Pokémon AR objects based on the user location.” Thus, the  
19 Turk Report merely elaborates on the contentions with information obtained during discovery.<sup>8</sup>

20 The infringement contentions were sufficiently broad to encompass both game modes. For  
21 instance, the contentions said:

22 The Pokémon Go game permits users to interact with Pokémon AR objects based  
23 on mobile phone/tablet computer location and the attributes of specific AR  
24 object(s). For example, the Pokémon Go game determines whether the user is given  
an opportunity to catch a Pokémon based on the device’s real-world location and  
the in-game location of the Pokémon AR object. The user’s movement relative to

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26 <sup>5</sup> Infringement Contentions – ECF No. 228-4 at 3.

27 <sup>6</sup> Mot. – ECF No. 228 at 9–10 (citing Infringement Contentions – ECF No. 228-4 at 17–19).

28 <sup>7</sup> *Id.* at 10–11 (citing Turk Report – ECF No. 227-2 at 55–64 (¶¶ 134–49) (under seal)).

<sup>8</sup> Opp’n – ECF No. 231 at 7–17.

1 the Pok  mon AR object determines whether the Pok  mon AR object is displayed at  
2 all and, if close enough, how that Pok  mon AR object is displayed on the Map  
3 View.<sup>9</sup>

4 This excerpt describes the Map View as a specific example of a broader contention. The broader  
5 contention — that Pok  mon Go satisfies the “determin[ing] whether to alter presence” limitation  
6 by enabling “users to interact with Pok  mon AR objects based on mobile phone/tablet computer  
7 location and the attributes of specific AR object(s)” — amounted to fair notice with respect to  
8 Pok  mon seen through a smartphone’s camera. The court thus denies the motion to strike  
9 paragraphs 134–49 of the Turk Report.

10 At the hearing, Niantic emphasized its argument that, stripped of the example, the contentions  
11 did not disclose much. A related point Niantic made is that (again stripped of the example) the  
12 contentions were too generalized under the local rules to adequately disclose an Encounters-based  
13 theory. N.D. Cal. Patent L.R. 3-1(c) (the claim chart must “identify[] specifically where and how  
14 each limitation of each asserted claim is found within each [accused instrumentality]”). In *DSS*  
15 *Tech. Mgmt., Inc. v. Apple, Inc.*, for example, the court described the purpose of Local Rule 3-1 as  
16 “to be nit-picky, to require a plaintiff to crystalize its theory of the case and patent claims.” No.  
17 14-cv-05330-HSG, 2020 WL 210318, at \*7 (N.D. Cal. Jan. 14, 2020) (cleaned up). The court held  
18 that the plaintiff’s infringement contentions disclosed only Bluetooth Sniff Subrating Mode and  
19 not Bluetooth Sniff Mode because the contentions “consistently reference[d] Bluetooth Sniff  
Subrating Mode” and were not clear enough on Sniff Mode. *Id.* at \*6–7.

20 The court appreciates this argument and it is true that NantWorks’ infringement contentions  
21 could have been more specific on the Encounters mode (especially given that they were specific  
22 on the Map View mode). But there is a balance that must be struck here and the court thinks it fair  
23 for the Turk Report to elaborate (via the Encounters mode) on NantWorks’ theory that in  
24 Pok  mon Go, users “interact with Pok  mon AR objects based on mobile phone/tablet computer  
25 location and the attributes of specific AR object(s).” *MasterObjects, Inc. v. Meta Platforms, Inc.*,  
26 No. C 21-05428 WHA, 2022 WL 4856269, at \*1 (N.D. Cal. Oct. 3, 2022) (“The rules do not  
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28 <sup>9</sup> Infringement Contentions – ECF No. 228-4 at 17.

1 require identification of every evidentiary item of proof, but the contentions must provide  
2 reasonable notice why the disclosing party believes it has a reasonable chance of proving its  
3 theory at trial.”).

4 The next issue is whether paragraphs 162–68, 171, and 240 of the Turk Report should be  
5 stricken on the ground that they introduce new infringement theories related to claims 22–23 of  
6 the ’051 patent. Asserted claim 22 recites: “The system of claim 1, wherein the determination of  
7 whether to alter presence of the relevant AR object depends on a time.” Asserted claim 23 recites:  
8 “The system of claim 22, wherein the presence alteration of the relevant AR object changes with  
9 the time.”<sup>10</sup>

10 NantWorks’ infringement contentions disclosed time-of-day-based functionality, “such as day  
11 versus night or ‘Spotlight Hours,’ which are times of day that allegedly increase the prevalence of  
12 a particular type of Pokémon.”<sup>11</sup> (The contention for claim 22 began “[s]ee claim 1,” and the  
13 contention for claim 23 began “[s]ee claim 22.”<sup>12</sup>) The Turk Report, on the other hand, allegedly  
14 introduces new theories of weather-based functionality and “awareness meter” functionality (a  
15 meter “that increases depending on the user’s movement[] and . . . causes the Pokémon to flee or  
16 jump behind bushes if the awareness meter fills up”).<sup>13</sup> NantWorks counters that the references to  
17 claim 1, from which claims 22 and 23 depend, are dispositive because the contention for claim 1  
18 “does discuss the [role] of weather in the determination of context and the related limitation  
19 ‘determine whether to alter presence of a relevant AR object based on at least the device location  
20 and the virtual attribute.’”<sup>14</sup>

21 In theory, an infringement contention for dependent claims could incorporate an earlier  
22 contention under Local Rule 3-1(c). But simply incorporating “claim 1” is a very generalized  
23 infringement contention because of the many limitations of claim 1. The rules do call for specific  
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25 <sup>10</sup> U.S. Patent No. 10,403,051 (filed Nov. 9, 2018) – ECF No. 114-2.

26 <sup>11</sup> Mot. – ECF No. 228 at 13–15.

27 <sup>12</sup> Infringement Contentions – ECF No. 228-4 at 26.

28 <sup>13</sup> Mot. – ECF No. 228 at 15.

<sup>14</sup> Opp’n – ECF No. 231 at 17–18.

1 identification of “where and how each limitation of each asserted claim is found within each  
2 [accused instrumentality].” N.D. Cal. Patent L.R. 3-1(c). In striking the relevant balance, the court  
3 thinks it would make the litigation “more fair” to strike paragraphs 162–68, 171, and 240 of the  
4 Turk Report.

5 **CONCLUSION**

6 The court grants the motion in part and strikes paragraphs 162–68, 171, and 240 of the Turk  
7 Report. This resolves ECF No. 228.

8 **IT IS SO ORDERED.**

9 Dated: March 12, 2024



10  
11 LAUREL BEELER  
12 United States Magistrate Judge  
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